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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,053	07/30/2004	Jun Fujimoto	256785US2XPCT	2145

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EXAMINER	
MOSSER, ROBERT E	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/502,053	FUJIMOTO ET AL.	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/06/04, 03/07/05,7/17/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **1** through **36** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function (MPEP 2105). In the present case the specification fails to set forth the equivalent structures or materials corresponding to the claimed means and accordingly fails to enable the invention. One of ordinary skill in the art would not readily recognize what components or devices would perform the functions associated with the disclosed means and accordingly implementation of the instant inventions would require undue experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1** through **36** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (in banc).

In this case the applicant has failed to correlate the claimed means to any equivalent structure and in such failed provide a basis for the determination of equivalency within the claims. One of ordinary skill in the art would not be apprised of the metes and bounds of the claimed invention in absence of this correlation as they are presently not provided with any disclosure to form a basis for such a determination.

Claims **7-18** and **25-36** are replete with improper antecedent basis issues. For example claims 7 and 25 refer to "the amount of money", claims 11 and 29 refer to "the user", and claims 12 and 29 refer to "the effect contents", there is insufficient antecedent basis for these limitations in the respective claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-5**, and **20-23** rejected under 35 U.S.C. 102(b) as being anticipated by Nakagawa et al (US 5,741,181).

Nakagawa et al teaches a game control means (Elm 3, 31) for controlling a horse racing game between a plurality of user console terminals (Fig 1) including:

allowing a plurality of user's to interact with the horse game through their respective terminal and wherein said interaction includes allowing the player to deposit monies, place wagers including forecast wagers, and receive the payout associated with the placed wager after the conclusion of the race (Col 5:19-39);

the determination of a game outcome including means to determine the winning wining horse and advancement means for advancing the competitive game (Col 10:66-11:36); and

the transmission of a game outcome to the respective terminal and conversion/execution of the transmitted game outcome in to a game payoff (Col 5:33-39).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **6-19** and **24-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa et al (US 5,741,181).

Claims **6, 13, 14, 16, 24, 31, 32,** and **34**: Nakagawa et al teaches the invention as disclosed above, however Nakagawa et al does not expressly state that the determination of the winning race horse occurs during the same time frame in which player's are allowed to enter the game. Nakagawa et al teaches the determination of the winning racehorse after the player wagers are placed.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to determined the winning race during the same time frame in which player's are allowed to enter the game because the Applicant has not disclosed that determined the winning race during the same time frame in which player's are allowed to enter the game provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Nakagawa et al determination of the winning horse and the

Applicant's determination of the horse to function equally well since the determined result is not presented to the device players until after the time to place wagers has expired.

Therefore it would have been prima facie obvious to modify the invention Nakagawa et al to obtain the invention as specified in claims 6 and 24, because such a modification would have been a mere design choice consideration which fails to patentably distinguish over the prior art of Nakagawa et al.

Claims **7, 11, 25**, and **29**: Nakagawa et al teaches the claimed obtainments means for obtaining the player forecast information as receiving means for accepting a wager and the calculation means as the determination of a payout amount based on the player forecast and odds (Col 5:19-39).

Claims **8** and **26**: The effect decision means is correlated to the race proceeding means disclosed by Nakagawa et al (10:66-11:36).

Claims **9-10** and **27-28**: Nakagawa et al teaches altering the effect decision means based on the number of users present at the device (Col 10:63-65).

Claims **12** and **30**: Nakagawa et al teaches the claimed start management means for displaying the effect contents after the elapse of the start time as the elapse of a betting ticket purchasing time and commencement of the race thereafter (Col 5:28-33).

Claims **15** and **33**: Nakagawa et al teaches the claimed effected time as being determined by the speed of the horses as controlled by a random number generation (Col 11:24-36).

Claims **17** and **35**: Nakagawa et al teaches the horses line up in their respective finish order after the race (Col 11:38-40).

Claims **18** and **36**: Nakagawa et al is silent regarding user authentication however the Examiner gives official notice the use of user authentication in wagering device is extremely old and well known and commonly utilized to prevent underage gambling. It therefore would have been obvious to one of ordinary skill in the art at the time of claimed invention to have incorporated the feature of user authentication into the invention of Nakagawa et al in order to avoid unauthorized use of the wagerding device of Nakagawa et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yi (US 5,795,226) teaches a betting game apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

REM
REM
December 8th, 2006

MARK SAGER
PRIMARY EXAMINER